

REMARKS

By this amendment, claims 250, 255, 262, 274, 280, 282, 287, 289, 291, 294-296, 298-299, 301, 304, and 307-311 have been amended. The specification has been amended to correct certain informalities. Accordingly, claims 250-322 are currently pending in the application, of which claims 250, 262, 274, 287, 299, and 311 are independent claims. Applicants appreciate the indication that claims 260, 261, 271, 273, 285, 286, 296, 298, 309, 310, 320 and 322 contain allowable subject matter.

Applicants respectfully submit that the above amendments do not add new matter to the application and are fully supported by the specification. Support for the amendments may be found at least at page 42, lines 6-20, and at page 49, lines 6-25 of the specification.

In view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Preliminary Matters

This continuation application was filed on April 15, 2004 with cancelled claims 1-249 and new claims 250-322. However, the Reply filed on August 10, 2005 listed a different set of claims (claims 250-304) from those filed on April 15, 2004. While the Notice of Non-Compliant Amendment mailed on August 24, 2005 highlighted this discrepancy, the same claim listing that was submitted on August 10, 2005 (i.e. claims 250-304) was re-submitted on September 19, 2005. A second Notice of Non-Compliant Amendment was not mailed in response to the September 19, 2005 filing. Further, an office action was mailed on December 8, 2005, in which claims 250-304 were examined. The reply filed on March 8, 2006, requested withdrawal of the December 8, 2005 office action and mailing of a second Notice of Non-Compliant Amendment.

The office action of December 8, 2005 was not withdrawn. Rather, a Notice of Abandonment was mailed on June 6, 2006. However, a second Notice of Non-Compliant Amendment was subsequently mailed on August 10, 2006 for Applicants' failure to submit the correct set of claims after the Notice of Non-Compliant Amendment mailed on August 24, 2005.

This Reply is provided in response to this second Notice of Non-Compliant Amendment mailed on August 10, 2006. Further, because the reply filed on August 10, 2005 included the incorrect set of claims, this reply addresses the examination contained in the reply mailed on March 10, 2005. Please do not consider the remarks filed on August 10, 2005 as they address the incorrect set of claims.

Applicants appreciate examiner's mailing of this second Notice of Non-Compliant Amendment, and respectfully request that examiner expressly withdraw the Notice of Abandonment mailed on June 6, 2006 upon timely receipt of this reply.

Claim Objection

In the Office Action, claims 260, 261, 271, 273, 285, 286, 296, 298, 309, 310, 320 and 322 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For the reasons asserted below, Applicants respectfully submit that these objected to claims depend from allowable base claims. Accordingly, Applicants respectfully request withdrawal of the objection for claims 260, 261, 271, 273, 285, 286, 296, 298, 309, 310, 320 and 322.

Rejection of Claims under Double Patenting

Claims 250-322 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-102 of U. S. Patent No. 6,741,868.

Applicants respectfully traverse this rejection for at least the following reasons.

A terminal disclaimer was filed on August 10, 2005, in which the term of any patent granted in this application subsequent to the expiration date of U. S. Patent No. 6,741,868 was waived and disclaimed. Accordingly, Applicants respectfully request withdrawal of the double patenting rejection of claims 250-322.

Claims 250, 262, 274, 287, 299 and 311 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U. S. Patent No. 6,782,274 ('274 patent). Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully submit that the obviousness-type double patenting rejection over U.S. Patent No. 6,782,274 should be withdrawn. First, Applicants respectfully submit that the examiner has failed to meet his burden in this obviousness-type double patenting rejection.

Under MPEP Chapter 804.II.B.1:

Any obviousness-type double patenting rejection should
make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

Applicants respectfully submit that the double patenting rejection in view of U. S. Patent No. 6,782,274 fails to make clear the differences between the claims subject to this rejection

and the claims of the issued '274 patent. Further, the rejection fails to make clear "why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent."

Moreover, the present application is a continuation application of U.S. Patent No. 6,741,868, which has a filing date of May 4, 2000. Thus, the present application's effective filing date is also May 4, 2000, which antedates the filing date of U.S. Patent No. 6,782,274 (October 23, 2000). Additionally, the term of U.S. Patent No. 6,782,274 is extended or adjusted under 35 U.S.C. 154(b) by 519 days, while the term of U.S. Patent No. 6,741,868 is extended or adjusted under 35 U.S.C. 154(b) by 0 days, and the terminal portion of any patent granted on this application subsequent to the expiration of U.S. Patent No. 6,741,868 has been waived and disclaimed per the Terminal Disclaimer filed August 10, 2005. Accordingly, Applicants submit that the policy underlying the judicially created doctrine of obviousness-type double patenting (i.e. preventing prolongation of the patent term) is inapplicable here.

Accordingly, Applicants respectfully request withdrawal of the double patenting rejection of claims 250, 262, 274, 287, 299 and 311 over claims 1-26 of U.S. Patent No. 6,782,274.

Claims 250-322 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 250-321 of copending U.S. Patent Application No. 10/825,281. Applicants respectfully traverse this rejection for at least the following reasons.

A terminal disclaimer was filed on August 10, 2005, in which the term of any patent granted in this application subsequent to the expiration date of any patent issuing from U.S. Patent Application No. 10/825,281 was waived and disclaimed. Accordingly, Applicants respectfully request withdrawal of the double patenting rejection of claims 250-322.

Claims 250-322 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 250-303 of copending U.S. Patent Application No. 10/824,929. Applicants respectfully traverse this rejection for at least the following reasons.

A terminal disclaimer was filed on August 10, 2005, in which the term of any patent granted in this application subsequent to the expiration date of any patent issuing from U.S. Patent Application No. 10/824,929 was waived and disclaimed. Accordingly, Applicants respectfully request withdrawal of the double patenting rejection of claims 250-322.

Rejections Under 35 U.S.C. § 102

Claims 250-252, 254, 258, 259, 262-264, 269, 270, 274-279, 287-289, 294, 295, 299-301, 303, 307, 308, 311-313, 318 and 319 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U. S. Patent No. 5,946,634 issued to Korpela ("Korpela"). Applicants respectfully traverse this rejection for at least the following reasons.

In order for a rejection under 35 U.S.C. § 102(e) to be proper, a single reference must disclose every claimed feature. To be patentable, a claim need only recite a single novel feature that is not disclosed in the cited reference. Thus, the failure of a cited reference to disclose one or more claimed features renders the 35 U.S.C. § 102(e) rejection improper.

Applicants respectfully submit that Korpela fails to disclose every limitation of the present invention. Claim 250 as amended recites, inter alia, "recognizing an operating type of the core network on the basis of a core network operating type information and core network information contained in a message" (emphasis added). Korpela fails to disclose at least these features.

The examiner relies upon Korpela's Fig. 9, steps 1202-1206 and col. 6, lines 29-41 to teach this feature of claim 250. Therein, Korpela discloses that a terminal "detects the network type code." Korpela, col. 6, lines 30-31. However, unlike in claim 250, Korpela fails to disclose

that a message contains both "core network operating type information and core network information." Thus, Korpela does not disclose "recognizing an operating type of the core network on the basis of a core network operating type information and core network information contained in a message." Accordingly, for at least this reason, Korpela fails to disclose every limitation of claim 250.

Similarly, claim 262 as amended recites, *inter alia*, "detection means for recognizing an operating type of the core network on the basis of a core network operating type information and core network information in a message" (emphasis added). Claim 274 as amended recites, *inter alia*, "recognizing an operating type of the core network on the basis of a core network operating type information and core network information contained in a message" (emphasis added). Claim 311 as amended recites, *inter alia*, "detection means for recognizing an operating type of the core network on the basis of a core network operating type information and core network information in a message" (emphasis added).

For at least the reasons asserted above with respect to claim 250, Korpela fails to disclose that a message contains both "core network operating type information and core network information." Accordingly, for at least this reason, Korpela fails to disclose every limitation of claims 262, 274, and 311.

Claim 287 as amended recites, *inter alia*, "detection means for recognizing an operating type of the core network on the basis of a core network operating type information and core network information" (emphasis added). Claim 299 as amended recites, *inter alia*, "recognizing an operating type of the core network on the basis of a core network operating type information and core network information" (emphasis added).

For at least the reasons asserted above with respect to claim 250, Korpela fails to disclose "recognizing an operating type of the core network on the basis of a core network

operating type information and core network information." Accordingly, for at least this reason, Korpela fails to disclose every limitation of claims 287 and 299.

Since none of the other prior art of record discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 250, 262, 274, 287, 299, and 311, and all the claims that depend therefrom are allowable. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection of claims 250-252, 254, 258, 259, 262-264, 269, 270, 274-279, 287-289, 294, 295, 299-301, 303, 307, 308, 311-313, 318 and 319.

Rejections Under 35 U.S.C. § 103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 253, 265, 277, 278, 290, 302 and 314 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Korpela. Applicants respectfully traverse this rejection for at least the following reasons.

As asserted above, none of the prior art of record, including Korpela, discloses or suggests all the features of independent claims 250, 262, 274, 287, 299, and 311. For at least this reason, all claims that depend therefrom are also allowable.

Claims 255-257, 266-268, 272, 280-282, 291-293, 297, 304-306, 315, 316, 317, and 321 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Korpela in view of U.S. Patent No. 6,137,806 issued to Martinez ("Martinez"). Applicants respectfully traverse this rejection for at least the following reasons.

Assuming *arguendo* that the references may be combined, the combined references do not disclose or suggest all of the claim limitations. As asserted above, none of the prior art of record, including Korpela, discloses or suggests all the features of independent claims 250, 262, 274, 287, 299, and 311. Martinez fails to remedy the shortcomings of Korpela. For at least this reason, all claims that depend therefrom are also allowable.

Claims 255-257, 266-268, 272, 280-282, 291-293, 297, 304-306, 315, 316, 317 and 321 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Korpela in view of U.S. Patent No. 6,389,008 issued to Lupien, *et al.* ("Lupien"). Applicants respectfully traverse this rejection for at least the following reasons.

Assuming *arguendo* that the references may be combined, the combined references do not disclose or suggest all of the claim limitations. As asserted above, none of the prior art of record, including Korpela, discloses or suggests all the features of independent claims 250, 262, 274, 287, 299, and 311. Lupien fails to remedy the shortcomings of Korpela. For at least this reason, all claims that depend therefrom are also allowable.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 253, 255-257, 265-268, 272, 277, 278, 280-282, 290-293, 297, 302, 304-306, 314-317 and 321. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants

respectfully submit that independent claims 250, 262, 274, 287, 299, and 311, and all the claims that depend therefrom, are allowable.

Allowable Subject Matter

Applicants appreciate the indication that claims 260, 261, 271, 273, 285, 286, 296, 298, 309, 310, 320 and 322 contain allowable subject matter.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Notice and Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

/hae-chan park/

Hae-Chan Park
Reg. No. 50,114

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H.C. Park & Associates, PLC
8500 Leesburg Pike
Suite 7500
Vienna, VA 22182
Tel: 703-288-5105
Fax: 703-288-5139
HCP/WMH/alj